

JAN 25 2008

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FAX TRANSMISSION COVER SHEET

Date : January 25, 2008
To : USPTO Attn: Examiner Duc Chi Ho
Fax : 1 571 273 3800
Subject : Our File: 8378/89588 (TEL-P-0042)
Sender : Paul M. Vargo

COMMENTS:

Please pages attached 4 pages.

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PTO/SB/21 (01-08)

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TRANSMITTAL
FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

4

Application Number

10/601,429

Filing Date

June 23, 2003

First Named Inventor

Robert B. Magill

Art Unit

2819

Examiner Name

Duc Chi Ho

Attorney Docket Number

8378/89586 (TEL-P-0042)

ENCLOSURES (Check all that apply)

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☐ Amendment/Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement

- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/ Incomplete Application
- ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation
- ☐ Change of Correspondence Address
- ☒ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ Landscape Table on CD

- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):
Letter

Remarks

Authorization to charge fees to Deposit Account is located on page 2 of the Letter accompanying this FAX transmission.

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Welsh & Katz, Ltd. associated with 24628

Signature

Printed name

Paul M. Vargo

Date

January 24, 2008

Reg. No.

29,116

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Paul M. Vargo

Date

Jan 25, 2008

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RECEIVED
CENTRAL FAX CENTER****JAN 25 2008**8378/89588 (TEL-P-0042)
PA 07 0004
Patent**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/601,429)
Applicants : Magill et al.)
Filed : June 23, 2003)
TC/A.U. : 2616)
Examiner : Duc Chi Ho)
Docket No. : 8378/89588 (TEL-P-0042))
PA 07 0004)
Customer No. : 24628)
Title : BI-DIRECTIONAL RING)
NETWORK HAVING)
MINIMUM SPARE)
BANDWIDTH ALLOCATION)
AND CORRESPONDING)
CONNECTION ADMISSION)
CONTROLS)

Confirmation No.: 7138

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Date**LETTER**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Applicant is filing herewith a Terminal Disclaimer as required by the Examiner responsible for the above-identified application. Applicants' position is that a Terminal Disclaimer is not required given the substantial differences between all of the claims of the present application, which correspond to Group II claims, divided out of the parent application and the claims of the patent which issued from the parent application, namely, U.S. Patent No. 6,606,297 B1. This Terminal Disclaimer is being filed without prejudice to

Appl. No. 10/601,429
Response to Notice of Allowance
and Issue Fee Due mailed Nov. 29, 2007

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Applicants' position that the requirement imposed by the Patent Office in this instance is improper and not consistent with U.S. Patent law nor the MPEP.

For purposes of clarifying the record of this prosecution; during the January 8, 2008, telephone conference initiated by the Examiner, a requirement for a Terminal Disclaimer was discussed. However, no agreement was reached at that time.

- (X) The Commissioner is hereby authorized to charge the Terminal Disclaimer fee \$130.00 under 37 CFR 1.20(d) to Deposit Account No. 23-0920.
- (X) The Commissioner is hereby authorized to charge any additional fees which may be required to this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 23-0920. Should no proper amount be enclosed herewith, as by a fee/check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920. *(If being filed by paper, a duplicate copy is enclosed)*

Respectfully submitted,

Dated: January 25, 2008

By 

Paul M. Vargo, Reg. No. 29,116
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**TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING
REJECTION OVER A "PRIOR" PATENT**Docket Number (Optional)
8378/89568 (TEL-P-0042)

In re Application of: Magill et al.

Application No.: 10/601,429

Filed: June 23, 2003

For: Bi-Directional Ring Network Having Minimum Spare Bandwidth Allocation and Corresponding Connection Admission Controls

The owner, Tellabs Operations, Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. US 6,806,297 B1 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:

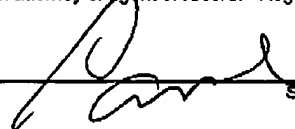
- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 29,116

 _____
Signature

January 24, 2008
Date

Paul M. Vargo
Typed or printed name

(312) 655-1500
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

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*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

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